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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/623,726	09/07/2000	Christer Alstermark	3525-94	6282

7590

06/03/2004

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EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/623,726	Applicant(s) ALSTERMARK ET AL.	
	Examiner Brenda Coleman	Art Unit 1624	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 20 November 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached Advisory Action.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: 16,26-34 and 38.

Claim(s) rejected: 1-15,17,18,24,25,35-37 and 39.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

ADVISORY ACTION

Claims 1-18 and 24-39 are pending in the application.

An appeal under 37 CFR 1.191 was filed in this application on November 20, 2003.

The amendment filed May 19, 2003 under 37 CFR 1.116 in response to the final rejection has been considered but is not deemed to place the application in condition for allowance and will **not** be entered because:

The amendment to claim 1 would raise the issue of new matter. The following reason(s) apply:

The proposed amendment to the proviso of claim 1 labeled (a) would raise the issue of new matter where B-CR₅R₆-A is a -CH₂- moiety. The proviso in the specification and the proviso of original claim 1 was such that when A and B are both single bonds and R⁷ is optionally substituted aryl, then R⁵ and R⁶ do not both represent H. The proposed proviso submitted with the response filed May 19, 2004 does not include the compounds where B-CR₅R₆-A is a -CH₂- moiety and thus claim 1 now includes those compounds where B-CR₅R₆-A is a -CH₂- moiety of which the specification lacks written description (35 U.S.C. § 112) and a statement of utility (35 U.S.C. § 101).

In addition to the presence of new matter in the proposed amendment there are also many other rejections and/or objections. The following are just a few:

- a) The proposed amendment to the specification includes in the fourth line from the bottom the compound GLG-V-13 (3-[4-(1H-imidazol-1-yl)benzoyl]7-iso-

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propyl-3,7-diazabicyclo[3.3.1]nonane) which indicates that the point of attachment of the imidazole is through a lower case L not a number 1.

b) The proposed amendment to claim 1 in the proviso includes the following, i.e. B-CR₅CR₆-A. It is not known what is meant by the second "C" between the R₅ and the R₆ and there are no variables R₅ and R₆ in the claim. It is believed that the applicants intended superscripts not subscripts.

c) Claim 2 lacks antecedent basis for the variable R', there is no variable R prime in claim 1.

d) Claim 6 contains in the fourth and fifth lines from the bottom "canyo".

e) Claim 7 contains the definition of R¹⁵ "independently", however, there is only one R¹⁵ mentioned.

f) Claim 7 also contains the statement that R¹⁵ together, which is not known with what.

g) Claim 11 also contains the additional limitation to the definition of A where A is also optionally interrupted by O.

h) Claim 15 contains in the sixth and ninth lines "akyl".

i) Claim 15 contains in the ninth line "prt".

j) Claim 16 contains preferably.

k) Claim 16 contains in the third line "substitutent".

l) Claim 25 contains in the process labeled (s) CO₂H, which is believed to be CO₂H with an O not a zero.

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- m) Claim 25 contains R^3 in the process labeled (w) which lacks antecedent basis.
- n) Claim 33 contains a proviso where R^7 does not represent optionally substituted phenyl which embraced by the proviso R_7 does not represent C_{1-6} alkyl or optionally substituted phenyl.
- o) Claim 33 contains the variable R_7 . It is believed that the applicants intended superscripts not subscripts.
- p) Claim 37 contains the organic acid "acetic is acid".
- q) Claim 38 contains the statement "cyano group is in he 4-position relative to B", where it is not known what "he" means.

The applicants are urged to review the claims for the above issues in any subsequent amendments.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 571-272-0674. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink that reads "Brenda Coleman". The signature is fluid and cursive, with a long horizontal stroke at the end.

Brenda Coleman
Primary Examiner Art Unit 1624
May 28, 2004